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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,075	05/22/2006	Antonio Fochesato	163-676	3656

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EXAMINER	
DAVIS, DEBORAH A	

ART UNIT	PAPER NUMBER
1655	

MAIL DATE	DELIVERY MODE
10/15/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/563,075	FOCHESATO, ANTONIO	
	Examiner	Art Unit	
	DEBORAH A. DAVIS	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 July 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) *10-21* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group 1, claims 1-9 in the reply filed on July 9, 2008 is acknowledged. The traversal is on the ground(s) that there is a technical relationship between the process and the product. This is not found persuasive because PCT Rule 13.1 the claims must for a single general inventive concept and under PCT 13.2 the two groups lack the same or corresponding special technical features. Group I involves a special technical feature of extracting terpenes and/or terpenoids from natural resins or essential oils in the presence of a rotating magnetic field, whereas the special technical feature of group II is an alcoholic and /or hydroalcohol solution containing free molecular structures of sesquiterpenes, terpenes and triterpenes. Therefore the two groups do not share a special technical feature that forms a single general inventive concept.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-4 and 8 rejected under 35 U.S.C. 102(b) as being anticipated by Zhou et al. (US 6,228,996).

A method for the extraction of terpenes and/or terpenoids from natural resins or essential oils by means of extraction with polar and/or semi-polar solvents in the presence of a rotating magnetic field.

The cited reference of Zhou et al. beneficially teaches the extraction of diterpenes glycosides (i.e. the major components of resin) from plants or botanical material with such polar solvents as ethanol (column 2, lines 52-67, e.g.). The extraction method can be carried out from 1 to 3 hours (see Example 1, e.g.). With respect to the extraction process carried out in the presence of a rotating magnetic field, the Earth is a rotating magnetic field and therefore reads on the instant claims.

Therefore, the cited reference is deemed to anticipate the instant claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuda et al. (US 2004/0072323).

The cited reference of Matsuda et al. beneficially teaches that terpenes, sesquiterpenes, monoterpenes and triterpenes are naturally occurring compounds extracted from plants and flowers (paragraph 0091, e.g.). Most terpenes are found in the resinous material and therefore read on propolis. The terpenes can be extracted

using ethanol as a solvent. Matsuda teaches a specific embodiment of extracting resinous containing compounds that include diterpenes which can be further purified and identified by NMR, which the examiner interprets as a rotating magnetic field (paragraph 0175, e.g.). The cited reference discloses that terpenes are medicinally useful (paragraph 0006, e.g.).

The cited reference of Matsuda does not specfically teach the percent by weight of the extraction solvent, the particular intensity ranges of the magnetic field, temperatures or length of extraction times.

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare such extracts of terpenes based on the beneficial teachings provided that terpenes are useful in medicines. The adjustment of particular conventional working conditions (e.g. determining suitable percentages by weight of the extraction solvent, the particular intensity ranges of the magnetic field, temperatures or length of extraction times) is deemed merely a matter of judicious selection and routine optimization, which is well within the purview of the skilled artisan.

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the reference, especially in the absence of the evidence to the contrary.

Conclusion

No claims are allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBORAH A. DAVIS whose telephone number is (571)272-0818. The examiner can normally be reached on 8-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Deborah A. Davis
Patent Examiner, AU 1600
October 2008

/Christopher R. Tate/
Primary Examiner, Art Unit 1655